

Request for Reconsideration:

Applicant failed to respond to the above-referenced Office Action within six (6) months of the notification date of this Office Action. On November 30, 2007, the PTO notified Applicant of the issuance of a Notice of Abandonment in the above-captioned patent application. Applicant is filing a Petition to Revive this application as unavoidably abandoned, accompanying this Responsive Amendment, and respectfully requests that the Examiner reconsider the above-captioned patent application in view of the following remarks.

Remarks:

1. Objections and Rejections.

The Office Action objects to **Figs. 3 and 4** as allegedly failing to include the label “Prior Art.” Claims 1-4 are pending in this application. Claims 1 and 4 stand rejected under 35 U.S.C. § 102(b), as allegedly anticipated by Patent No. US 5,588,807 A to Kimura et al. (“Kimura”). Further, claims 1-3 stand rejected under 35 U.S.C. § 103(a), as allegedly rendered obvious by Applicant’s allegedly Admitted Prior Art in view of Kimura. Applicant disagrees.

2. Objections to the Drawings.

The Office Action objects to **Figs. 3 and 4** as allegedly failing to include the label “Prior Art.” Applicant is amending **Figs. 3 and 4** to include the label “Prior Art.” Therefore, Applicant respectfully requests that the Examiner withdraw the objections to **Figs. 3 and 4**.

3. Anticipation Rejections.

As noted above, claims 1 and 4 stand rejected as allegedly anticipated by Kimura. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. . . . ‘The identical invention must be shown in as complete detail as is contained in the . . . claim.’” MPEP 2131 (citations omitted). The Office Action asserts that Kimura discloses each and every element of claim 1 and 4. Applicant respectfully disagrees.

The Office Action contends that the Kimura discloses “a displacement control valve (figs. 1, 5, 6) disposed in a discharge supply passage way (23, 24) and a fixed orifice Oa in part of a pressure relief passageway 23, 24 formed within the control valve (see [Kimura] fig. 5) . . .” Office Action, Page 2, Lines 22-24. Nevertheless, Applicant’s claim 1 describes (1) “a displacement control valve disposed at a position in a discharge pressure supply passageway capable of communicating with said crank chamber from said discharge chamber” and (2) “a fixed orifice disposed at a position in a pressure relief passageway communicating with said suction chamber from said crank chamber.” Thus, the control valve is in the “discharge pressure supply passageway” which is capable of communicating with the crank chamber from the discharge chamber while the fixed orifice is disposed at a position in a pressure relief passageway communicating with the suction chamber from the crank chamber.

Applicant maintains that the Examiner has misapplied Kimura to Applicant's claim 1. Referring to Kimura's **Fig. 5**, fixed orifice Oa is positioned in upstream communication passage 23A. Kimura, Column 5, Lines 24-26. As Kimura explains,

[w]hen the compressor runs with the maximum displacement in the second embodiment, therefore, refrigerant gas is supplied from discharge chamber 4b to crank chamber 2a via the upstream communication passage 23A and the restriction Oa, other than by blow-by gas from the compression chambers 18. . . . The high pressure refrigerant gas in the discharge chamber 4b will not reach the communication passage 23 due to the action of restriction Oa.

Id. at Lines 36-55. Thus, unlike Applicant's fixed orifice, restriction Oa is not disposed "at a position in a pressure relief passageway communicating with said suction chamber from said crank chamber" (emphasis added), and Kimura does not disclose this element of claim 1. Therefore, Applicant respectfully requests that the Examiner withdraw the anticipation rejection of claim 1.

In addition, according to Applicant's claim 4, "said fixed orifice is formed in said displacement control valve." The Office Action does not show that any embodiment of Kimura describes restriction Oa as "formed in" Kimura's control valve 25. See Kimura, Column 3, Lines 48-65. Therefore, Applicant respectfully requests that the Examiner withdraw the anticipation rejection of claim 4.

4. Obviousness Rejections.

As noted above, claims 1-3 stand rejected as allegedly rendered obvious by Applicant's allegedly Admitted Prior Art in view of Kimura. In order to establish a prima facie case of obviousness, the Office Action must satisfy three (3) criteria. First, the cited references must disclose or suggest all of the claim limitations. Second, there must be some apparent reason, either in the references themselves or in the knowledge generally available to those of ordinary skill in the art, to modify the primary reference as proposed by the Office Action. Third, there must be a reasonable expectation of success. MPEP 2143.

According to the Office Action, Applicant's Admitted Prior Art is the description in the specification of the known compressor depicted in Applicant's **Figs. 3 and 4**. The Office Action contends that the compressor described in Applicant's specification with respect to **Figs. 3 and 4** includes all of the limitations of Applicant's claims 1-3, except for "a part of discharge pressure supply passageway 23, 24 and a part of pressure relief passageway 23, 24 are formed as

a common passage way 24 in order to suppress the circulation of gas in the crank chamber, thus suppressing the discharge of lubricating oil . . .” Office Action, Page 3, Line 25, through Page 4, Line 3. Nevertheless, the Office Action contends that Kimura supplies these missing elements and that a person of ordinary skill in the art would have had reason to modify the known compressor in view of Kimura to achieve the invention described in Applicant’s claims 1-3. Applicant respectfully disagrees.¹

In his specification, Applicant describes the one-way flow of the known compressors.

In the above-described variable displacement compressor 50, the discharge pressure supply passageway from discharge chamber 64 to crank chamber 55 is formed by communication passageways 68, 1e, 1g and 66, and the pressure relief passageway from crank chamber 55 to suction chamber 65 is formed by the gap between compressor main shaft 56 and bearing 77, gas chamber 84 and fixed orifice 83. In these discharge pressure supply passageway and pressure relief passageway, the flow of the gas supplied from discharge chamber 64 always becomes a one-way flow of discharge chamber 64 → displacement control valve 10 → crank chamber 55 → gas chamber 84 → fixed orifice 83 → suction chamber 65. In such a passageway structure wherein only a one-way flow occurs, for example, when the gas flow speed is in a low-flow speed range, on the way of the passageway, for example, at a position of bearing 77 or shaft supporting member 78 or a vicinity thereof, the flow is liable to stagnate, and accompanying with it, foreign matters in the gas are liable to accumulate. Such a foreign matter accumulation may cause an abrasion of, in particular, bearing 77 or compressor main shaft 56, and may damage the reliability of the compressor.

Further, in the above-described variable displacement compressor 50, because two communication passageways of the discharge pressure supply passageway from discharge chamber 64 to crank chamber 55 and the pressure relief passageway from crank chamber 55 to suction chamber 65 are necessary, the processing of cylinder block 51 may become complicated.

Appl’n, Page 4, Line 8, through Page 5, Line 1 (emphasis added).

The Office Action contends that Kimura provides a reason for modifying the known compressors to achieve Applicant’s claimed invention. Specifically, with respect to the embodiment depicted in Kimura’s **Fig. 5**, Kimura states that:

¹ In the Office Action, Page 4, Line 7, the Office Action incorrectly refers to “Kimura ‘026.” Applicant’s representative has spoken with the Examiner and confirmed that the Examiner intended to refer again to the Applicant’s allegedly Admitted Prior Art.

[s]ince the supply of the refrigerant gas into the crank chamber 2a and the discharge of the refrigerant gas from the crank chamber 2a are also accomplished by the single passage 24 only in this embodiment, the circulation of the refrigerant gas in the crank chamber 2a is suppressed, thus suppressing the discharge of the lubricating oil.

Kimura, Column 6, Lines 6-11 (cited in Office Action, Page 4, Lines 2-5). Kimura states that this two-way flow to and from the crank chamber 2a through a single passageway occurs only in the embodiment of **Fig. 5**. Nevertheless, the embodiment of **Fig. 5** appears to achieve this two way flow by including restriction Oa between the crank chamber and the discharge chamber, contrary to claim 1. The Office Action cannot pick and choose elements from the cited art. Instead, the Office Action must consider the cited art as a whole, including those elements that do not suggest the proposed combination. MPEP 2141.02. Therefore, Applicant maintains that the Office Action has failed to demonstrate a reason to modify the known compressor in view of Kimura to achieve the invention of Applicant's claim 1.

In addition, "[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." MPEP 2143.01(VI). Applicant maintains that because the known compressor - at least those relied upon by the Examiner as the primary reference - is designed to achieve the one-way flow described above, the modifications proposed by the Examiner to create a bidirectional flow would change a principle of operation of that compressor. Consequently, those modifications are not sufficient to render claim 1 *prima facie* obvious.

Finally, "[i]f an independent claim is non-obvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious." MPEP 2143.03. Thus, because claims 2 and 3 depend from claim 1 and because claim 1 is not rendered obviousness by the cited references, the rejections of claims 2 and 3 are untenable. Therefore, Applicant respectfully requests that the Examiner withdraw the obviousness rejections of claims 2 and 3

Conclusion:

Applicant maintains that the above-captioned patent application is in condition for allowance, and such disposition is earnestly solicited. If the Examiner believes that the prosecution of this application may be furthered by discussing the application, in person or by telephone, with Applicant's representatives, Applicant's representatives would welcome the opportunity to do so. Applicant believe that no additional fees are due as a result of filing this

responsive amendment accompanying the Petition to Revive. Nevertheless, in the event of any variance between the fees determined by Applicant and the fees determined by the PTO, please charge or credit any such variance to the undersigned's **Deposit Account No. 02-0375**.

Respectfully submitted,
BAKER BOTTS L.L.P.

Dated: **December 31, 2007**

By: 

James B. Arpin
Registration No. 33470

Baker Botts L.L.P.
The Warner; Suite 1300
1299 Pennsylvania Avenue, N.W.
Washington, D.C. 20004-2400
(202) 639-7700 (telephone)
(202) 639-7890 (facsimile)

JBA/djw

Attachments

TAB C

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number

<p>Effective on 12/08/2004. Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).</p> <h2 style="margin: 0;">FEE TRANSMITTAL</h2> <h3 style="margin: 0;">For FY 2008</h3>		<p>Complete if Known</p>	
<input type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27		Application Number	10/510,340
		Filing Date	2004-10-05
		First Named Inventor	Yukihiko Taguchi
		Examiner Name	Patrick Hamo
		Art Unit	3746
TOTAL AMOUNT OF PAYMENT		(\$)	510
		Attorney Docket No.	018842.1318

METHOD OF PAYMENT (check all that apply)

☐ Check
 ☐ Credit Card
 ☐ Money Order
 ☐ None
 ☐ Other (please identify): _____

☒ Deposit Account
 Deposit Account Number: 020375
 Deposit Account Name: Baker Botts LLP

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☒ Charge fee(s) indicated below
 ☐ Charge fee(s) indicated below, **except for the filing fee**

☒ Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17
 ☒ Credit any overpayments

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

FEE CALCULATION

1. BASIC FILING, SEARCH, AND EXAMINATION FEES

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	310	155	510	255	210	105	
Design	210	105	100	50	130	65	
Plant	210	105	310	155	160	80	
Reissue	310	155	510	255	620	310	
Provisional	210	105	0	0	0	0	

2. EXCESS CLAIM FEES

Fee Description	Fee (\$)	Small Entity Fee (\$)
Each claim over 20 (including Reissues)	50	25
Each independent claim over 3 (including Reissues)	210	105
Multiple dependent claims	370	185

Total Claims **Extra Claims** **Fee (\$)** **Fee Paid (\$)**

- 20 or HP = _____ x _____ = _____

HP = highest number of total claims paid for, if greater than 20.

Indep. Claims **Extra Claims** **Fee (\$)** **Fee Paid (\$)**

- 3 or HP = _____ x _____ = _____

HP = highest number of independent claims paid for, if greater than 3.

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$260 (\$130 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fee Paid (\$)
_____	_____	_____	_____	_____

_____ - 100 = _____ / 50 = _____ (round up to a whole number) x _____ = _____

4. OTHER FEE(S)

	Fees Paid (\$)
Non-English Specification, \$130 fee (no small entity discount)	
Other (e.g., late filing surcharge): FEE CODE 1452	510

SUBMITTED BY

Signature	/James B. Arpin/	Registration No. 33470 (Attorney/Agent)	Telephone 202-639-7735
Name (Print/Type)	James B. Arpin	Date December 31, 2007	

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.